

## **REMARKS**

### **A. Proposed Amendment to Drawings**

On February 27, 2004, Applicants filed a Proposed Amendment to the Drawings regarding FIG. 1. Page one of the Office Action mailed on August 25, 2004 states that the drawings filed on February 27, 2004 were accepted by the Examiner. Applicants will take this to mean that Applicants Proposed Amendment to the Drawings has been accepted.

### **B. 35 U.S.C. § 102**

#### **1. Larsen et al.**

##### **a. Claims 1-3 and 6**

In the Office Action mailed on August 25, 2004, claims 1-3 and 6 and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Larsen et al. Claim 1 has been amended to clarify that the recited torque causes “a mechanical stress to be applied to said printed circuit board during said rotary movement.” In contrast, Larsen et al. does not disclose that a torque required for rotary movement for the rotor 26 is caused by circuit board 40. In addition, Larsen et al. does not disclose that the torque causes a mechanical stress on the board 40 during the rotary motion. Accordingly, claim 1 and its dependent claims 2, 3 and 6 are not anticipated by Larsen et al.

Besides not being anticipated by Larsen et al., claims 1-3 and 6 are not rendered obvious by Larsen et al. since there is no motivation in either Larsen et al. or the prior art to 1) having board 40 cause a torque required for rotary movement of the rotor 40 and 2) having the torque required for rotary movement of the rotor 40 causing a mechanical stress on the board 40 during the rotary movement.

**b. Claim 8**

Claim 8 was rejected under 35 U.S.C. § 102(b) as being anticipated by Larsen et al.

Claim 8 has been amended to clarify that the recited torque causes “a mechanical stress to be applied to said printed circuit board during said rotary movement.” For at least the same reasons given above in Section B.1.a, claim 8 is not anticipated nor rendered obvious by Larsen et al. Accordingly, the rejection should be withdrawn.

**2. England et al.**

Claims 9, 10 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by England et al. Claim 9 has been amended to clarify that the connecting wires of the stator “are conducted inside of said slip ring unit essentially in an axial direction and are respectively in electrical contact with said stator and said rotor.” England et al.’s stator coils 17-19 are not conducted inside of the motor 1 essentially in an axial direction. Furthermore, the coils 17-19 are wound on the stator and do not contact the rotor. (Col. 4, ll. 24-28). Accordingly, claim 9 and its dependent claims 10 and 14 are not anticipated by England et al. and so the rejection should be withdrawn.

Besides not being anticipated by England et al., claim 9 is not rendered obvious by England et al. since there is no motivation to have stator coils 17-19 conducted inside of the motor 1 essentially in an axial direction and contacting the rotor. Accordingly, claim 9 and its dependent claims 10 and 14 are patentable over England et al.

**C. 35 U.S.C. § 103**

**1. Larsen et al. and Kaneda et al.**

Claims 4 and 5 were rejected under 35 U.S.C § 103 as being obvious in view of Larsen et

al. and Kaneda et al. Claims 4 and 5 depend indirectly on claim 1. As pointed above in Section B.1, Larsen et al. does not disclose or suggest 1) having board 40 cause a torque required for rotary movement of the rotor 40 and 2) having the torque required for rotary movement of the rotor 40 causing a mechanical stress on the board 40 during the rotary movement. Kaneda et al. does not cure the deficiencies of Larsen et al. in that Kaneda et al. does not suggest altering Larsen et al. so that Larsen et al.'s board 40 cause a torque required for rotary movement of the rotor 40 and having the torque required for rotary movement of the rotor 40 causing a mechanical stress on the board 40 during the rotary movement. Without such suggestion, the rejection should be withdrawn.

**2. Larsen et al. and Taguchi et al.**

**a. Claim 7**

Claim 7 was rejected under 35 U.S.C § 103 as being obvious in view of Larsen et al. and Taguchi et al. Claim 7 depends indirectly on claim 1. As pointed above in Section B.1, Larsen et al. does not disclose or suggest 1) having board 40 cause a torque required for rotary movement of the rotor 40 and 2) having the torque required for rotary movement of the rotor 40 causing a mechanical stress on the board 40 during the rotary movement. Taguchi et al. does not cure the deficiencies of Larsen et al. in that Taguchi et al. does not suggest altering Larsen et al. so that Larsen et al.'s board 40 cause a torque required for rotary movement of the rotor 40 and having the torque required for rotary movement of the rotor 40 causing a mechanical stress on the board 40 during the rotary movement. Without such suggestion, the rejection should be withdrawn.

**b. Claim 17**

Claim 17 was rejected under 35 U.S.C § 103 as being obvious in view of Larsen et al. and Taguchi et al. Claim 17 has been amended to clarify that the recited torque causes “a mechanical stress to be applied to said printed circuit board during said rotary movement.” As pointed out above in Section B.1.a, Larsen et al. does not disclose or suggest 1) having board 40 cause a torque required for rotary movement of the rotor 40 and 2) having the torque required for rotary movement of the rotor 40 causing a mechanical stress on the board 40 during the rotary movement. Taguchi et al. does not cure the deficiencies of Larsen et al. in that Taguchi et al. does not suggest altering Larsen et al. so that Larsen et al.’s board 40 cause a torque required for rotary movement of the rotor 40 and having the torque required for rotary movement of the rotor 40 causing a mechanical stress on the board 40 during the rotary movement. Without such suggestion, the rejection should be withdrawn.

**3. England et al. and Larsen et al.**

**a. Claim 11**

Claim 11 was rejected under 35 U.S.C § 103 as being obvious in view of England et al. and Larsen et al. Claim 11 depends directly on claim 9. As pointed above in Section B.2, England et al. does not disclose or suggest having stator coils 17-19 conducted inside of the motor 1 essentially in an axial direction and contacting the rotor. Larsen et al. does not cure the deficiencies of England et al. in that Larsen et al. does not suggest altering England et al. so that stator coils 17-19 are conducted inside of the motor 1 essentially in an axial direction and contact the rotor. Without such suggestion, the rejection is improper and should be withdrawn.

**b. Claim 16**

Claim 16 was rejected under 35 U.S.C § 103 as being obvious in view of England et al. and Larsen et al. Claim 16 has been amended to clarify that a torque introduced by the printed circuit board and required for rotary movement between the rotor and the stator causes “a mechanical stress to be applied to said printed circuit board during said rotary movement.” In contrast, England et al. does not disclose that its printed circuit board 13 causes a torque required for rotary movement of the rotor 20 and 2) having the torque required for rotary movement of the rotor 20 causing a mechanical stress on the board 20 during the rotary movement. As pointed out above in Section B.1.a, Larsen et al. does not disclose or suggest having its board 40 cause a torque required for rotary movement of the rotor 40 and 2) having the torque required for rotary movement of the rotor 40 causing a mechanical stress on the board 40 during the rotary movement. Accordingly, Larsen et al. does not suggest altering England et al.’s printed circuit board 13 to cause a torque required for rotary movement of the rotor 20 and having the torque required for rotary movement of the rotor 20 causing a mechanical stress on the board 20 during the rotary movement. Accordingly, the rejection should be withdrawn.

**4. England et al. and Kaneda et al.**

Claims 12 and 13 were rejected under 35 U.S.C § 103 as being obvious in view of England et al. and Kaneda et al. Claims 12 and 13 depend indirectly on claim 9. As pointed above in Section B.2, England et al. does not disclose or suggest having stator coils 17-19 conducted inside of the motor 1 essentially in an axial direction and contacting the rotor. Kaneda et al. does not cure the deficiencies of England et al. in that Kaneda et al. does not suggest altering England et al. so that stator coils 17-19 are conducted inside of the motor 1 essentially in

an axial direction and contact the rotor. Without such suggestion, the rejection is improper and should be withdrawn.

**5. England et al. and Taguchi et al.**

Claim 15 was rejected under 35 U.S.C § 103 as being obvious in view of England et al. and Taguchi et al. Claim 15 depends indirectly on claim 9. As pointed above in Section B.2, England et al. does not disclose or suggest having stator coils 17-19 conducted inside of the motor 1 essentially in an axial direction and contacting the rotor. Larsen et al. does not cure the deficiencies of England et al. in that Larsen et al. does not suggest altering England et al. so that stator coils 17-19 are conducted inside of the motor 1 essentially in an axial direction and contact the rotor. Without such suggestion, the rejection is improper and should be withdrawn.

**6. England et al., Taguchi et al. and Funk**

Claims 18 and 19 were rejected under 35 U.S.C § 103 as being obvious in view of England et al., Taguchi et al. Claims 18 and 19 depend indirectly on claim 9. As pointed above in Section C.5, both England et al. and Taguchi et al. do not suggest altering England et al. so that England et al.'s stator coils 17-19 are conducted inside of the motor 1 essentially in an axial direction and contact the rotor. Funk et al. does not cure the deficiencies of England et al. and Taguchi et al. in that Funk does not suggest altering England et al. so that stator coils 17-19 are conducted inside of the motor 1 essentially in an axial direction and contact the rotor. Without such suggestion, the rejection is improper and should be withdrawn.

**D. New Claim 20 and 21**

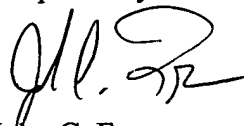
Claims 20-21 are being presented to provide additional coverage for a device for transferring electric currents and so are not being presented for reasons related to patentability as

defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

### CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-21 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



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Dated: February 23, 2005